

## **REMARKS**

Applicants would like to thank the Examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office action of February 13, 2008, and only slightly amended to correct punctuation in claims 3 and 5. It is believed that the claims clearly and particularly describe the subject matter which applicants regard as the invention and, further, that all pending claims, in their present form, are patentably distinct and unobvious over the art of record.

Claims 7-9 were previously rejected in the initial Office action of August 7, 2007 because, according to the Examiner, the claimed invention was directed to non-statutory subject matter. Original claims 7-9 were directed to and recited "a program" which, according to the Examiner, is not statutory subject matter under 35 USC § 101. Accordingly, each of claims 7-9 were amended in the Amendment A filed on December 7, 2007 to recite a program stored in a computer readable medium for a combined equipment selection system. The rejection of claims 7-9 under 35 USC § 101 has now been withdrawn.

In addition, the Abstract of the Disclosure was previously objected to in the initial Office action of August 7, 2007 because, according to the Examiner, it contained legal phraseology. Correction was tendered in the Amendment A filed on December 7, 2007. The Examiner has now indicated that the new Abstract complies with the MPEP. Accordingly, the objection to the specification has been withdrawn.

Lastly in the initial Office action of August 7, 2007, claims 1-9 were rejected under 35 USC § 103(a) as being unpatentable over U.S. Publication No. 2006/0085282 to Hanai et al. (hereinafter "Hanai"). Applicants tendered

amendments to selected claims and presented arguments into the record in the Amendment A of December 7, 2007.

The Examiner now considers applicants' previous arguments and amendments to be moot and has refined the position of the Office with regard to claims 1-9. In particular, at present, claims 1-9 stand rejected under 35 USC § 103(a) as being unpatentable over Hanai in view of U.S. Publication No. 2003/0110443 to Yankovich et al. (hereinafter "Yankovich").

The Examiner took the position on pages 3 and 4 of the action that Hanai generally teaches each of the elements of the independent claims but does not specifically disclose "means for carrying out a selection operation which selects one or more other combined equipment which is different from the service equipment and is suitable for being combined with the service equipment, based on model information and operational conditions of the service equipment entered from the operations section, and the constant data stored in the constant memory means" included on the user terminal. Further, the Examiner concedes on the top of page 5 of the action that in the embodiment pictured in Figures 1 and 4 of Hanai, "the selection system resides in the server and not in the user terminal." However, the Examiner further took the position that "Yankovich discloses processing information on the client side of a client-server system (paragraph 69) for the purpose of reducing the load on the server." Thus, according to the Examiner, it would have been obvious to one of ordinary skill in the art at the time of applicants' invention "to modify Hanai by performing the processing (selection system) on the client side as taught by Yankovich for the purpose of reducing server load." Further, according to the Examiner, "Yankovich teaches that by doing so the system may support a greater number of clients (paragraph 69)." Applicants respectfully disagree and

submit that claims 1-9 are patentably distinct and unobvious over the art of record for at least the reasons set out below.

It is instructive to first consider the invention being claimed in the present application. Turning to the claims pending in the instant application and using claim 1 by way of example, a selection operation is carried out by respective user terminal devices. The user terminal device transmits user information and selection information to the host computer. The user terminal device displays the selection information onto the display section of the user terminal device only when a display permission is obtained by the user terminal device from the host computer. In the claims pending in the instant application, the host computer is not claimed to carry out the selection operation but rather the user terminal device is claimed to perform the selection operation. The host computer merely stores in a memory the user information and the selection information which have been transmitted from the user terminal device, and gives the user terminal device the display permission that permits the selection information to be displayed on the display section of the user terminal device.

Systems and software formed in accordance with the claims of the present application have many technical and commercial advantages. The workload does not significantly increase on the host computer side when there are many user terminal devices, since the host computer does not itself carry out the selection operation. As set out in the claims, the user terminal devices execute the selection operations. In addition, since the user of the terminal devices must access the host computer in order to obtain the selection information, it appears to the user who operates the user terminal that the host computer carries out the selection operation and that the selection information is obtained from the host computer. Rather, as

set out in the claims, permission to display the selection information is obtained from the host computer but, again, the user terminal device executes the selection operation.

A still further commercial and technical advantage of the system in the present application is that the host computer does not fail to obtain the information from the user whenever the selection information is displayed on the user terminal device. Although the host computer does not carry out the selection operation itself, the host computer obtains the information from the user whenever the selection information is displayed on the user terminal device.

In contradistinction thereto, in the system of Hanai such as shown in Figure 1 thereof, a client terminal 31 communicates with a shopping server 15. The client terminal 31 corresponds to a user terminal device such as set out in the claims of the present application, while the shopping server 15 corresponds to the host computer device in the present application. A related item DB 257 is included in a shopping DB 25 on the shopping server 15 end. In the system of Hanai, a selection operation is carried out by the shopping service 15 which corresponds to the host computer of the present application, and the shopping server 15 of Hanai transmits the selection information to the client terminal 31. This process is described paragraphs [0093]-[0095] in the specification of Hanai. Thus, in the system of Hanai, as the number of client terminals 31 increases, a workload will accordingly increase on the shopping server 15 end. The first sentence in paragraph [0092] of Hanai indicates that the shopping server 15 executes the processing shown in Figure 9 thereof. In addition, the first sentence of paragraph [0095] of Hanai indicates that an HTML document is transmitted to the client terminal 31 to be displayed thereon such as indicated at S16 of Figure 9. Thus, Hanai specifically

states that the shopping server 15 executes the selection operation steps set out in Figure 9, and, thereafter, transmits the selection information in the form of an html document transmitted to the client terminal 31 for display thereon.

The present application is aimed at solving the problem of an increased workload on a host computer when a plurality of user terminal devices are added thereto. The host computer in the present application corresponds to the shopping server 15 in Hanai but, unlike the teaching of Hanai, the host computer in the present application does not carry out the selection operation but merely stores in a memory the user information and the selection information which have been transmitted from the user terminal device which corresponds to the client terminal 31 in Hanai, and then gives a display permission to the user terminal device. In accordance with the claims, the user terminal device executes the selection processing. Specifically, each of the plurality of user terminal devices includes means for carrying out a selection operation which selects the selection information and displays the selection information when the display permission is obtained from the host computer.

Overall, therefore, it is respectfully submitted that a reduction in the workload on a host computer end is a fundamental advantage of the invention of the present application. However, Hanai does not disclose or suggest this idea, namely, the aspect of reducing the workload on the host computer (shopping server 15) end. As noted above, the shopping server 15 performs the steps shown in Figure 9 and as described in paragraphs [0093]-[0095].

Each of independent claims 1-9 include the feature of a selection operation being performed by a user terminal device. Hanai teaches performing such operations exclusively on the host computer. Accordingly, it is respectfully submitted

that each of independent claims 1-9 are patentably distinct and unobvious over the art of record, including Hanai. In addition, it is respectfully submitted that Hanai itself does not teach, suggest, or disclose performing the processing operations on the client side or on the terminals. Motivation for such a modification, if it were possible, could only come from the pending claims in this application.

According to the Examiner, Yankovich discloses a generic "processing information on the client side of a client-server system (paragraph 69) for purposes of reducing the load on the server." The Examiner then seeks to modify the teachings of Hanai (processing at server) with the alleged teachings of Yankovich (processing at client side).

First, it is respectfully submitted that Hanai cannot be modified in the manner as suggested by the Examiner. One reason is that the shopping database DB 25 in Hanai is on the server side and the processing in the shopping server 15 requires access to this database 25. Perhaps the Examiner would further modify the teachings of Hanai to move the database 25 to the client side as well. In addition, if the processing of the shopping server 15 is moved to the client side such as into the clients 31, then what processing would remain on the server side to perform the other functions recited in the claims such as, for example, "storing said user information and said selection information obtained from said user terminal device" or "transmitting said permission to said user terminal device when the user information and the selection information are entered from the user terminal device?"

It is further respectfully submitted that even if Hanai was modified in the manner as suggested by the Examiner, it would still fall short of the inventions recited in the pending claims. Despite the Examiner's contentions, Hanai does not

teach various aspects recited in the claims including but not limited to "a means for requesting a display permission from the host computer for displaying the selection information ... and displaying the selection information onto the display section only when the display permission is obtained form the host computer." Here the Examiner has attempted to interpret a "log-in" as a display permission request. However, the underlying item to be displayed in the event that the display permission is granted is wholly lacking in Hanai.

In addition to the above, it is respectfully submitted that none of the prior art cited, alone or in combination teaches, suggests, or fairly discloses "a means for requesting a display permission from the host computer for displaying the selection information selected by the means for carrying out the selection operation onto the display section on condition that the user information and the selection information are transmitted to the host computer, and displaying the selection information onto the display section only when the display permission is obtained from the host computer" as recited in claim 1. The other independent claims have similar distinguishing features over the art.

Further, overall, it is respectfully submitted that none of the prior art cited, alone or in combination teaches, suggests, or fairly discloses "said host computer includes a means for storing the user information and the selection information obtained form the user terminal device, and a means for transmitting the display permission to the user terminal device when the user information and the selection information are entered from the user terminal device" as recited in claim 1. The other independent claims have similar distinguishing features over the art.

Yet another reason as to why the present rejections are deficient and must be withdrawn and all claims allowed, relates to the recently issued "Examination

Guidelines for Determining Obviousness Under 35 USC 103 In View of the Supreme Court Decision in *KSR International Co. v. Teleflex*," published in the Federal Register, Vol. 72, No. 195, Oct. 10, 2007.<sup>1</sup> As explained in those guidelines, the Supreme Court stated that "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." Fed Reg. 57528-57529, citing *KSR*, 550 US at \_\_\_\_, 82 USPQ2d at 1396.

In the final Office action of February 13, 2008, the Examiner took the position that "it would have been obvious, to one of ordinary skill in the art, at the time of the invention to modify Hanai by performing the processing (selection system) on the client sic. as taught by Yankovich for purposes of reducing server load." The Examiner then proceeded to assemble the claimed invention from selected portions of the prior art teachings.

The Examination Guidelines were not available to the Examiner in August of 2007 to use and/or apply in the initial Office action, but they were available for use in the second Office action of February 13, 2008. However, it does not appear that the Examiner chose to use these prescribed Guidelines in reiterating and/or in clarifying the positions taken by the Office such as might be expected in a second Office action citing new grounds of rejection.

In general, the Examination Guidelines describe specific findings that the Examiner must make in order to properly reject claims under various rationales. One of the accepted rationales, and one which the Examiner apparently relies upon, is "Use of Known Technique to Improve Similar Devices in the Same Way." Another of the accepted rationales, and one which the Examiner may be relying upon, is

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<sup>1</sup> The Guidelines state that they are effective October 10, 2007.



"Applying a Known Technique to a Known Device Ready for Improvement to Yield Predictable Results."

Under the first rationale of "Use of Known Technique to Improve Similar Devices in the Same Way":

To reject a claim based on this rationale, Office personnel must resolve the *Graham* factual inquiries. Office personnel must then articulate the following:

(1) a finding that the prior art contained a "base" device upon which the claimed invention can be seen as an "improvement;"

(2) a finding that the prior art contained a "comparable" device that was improved in the same way as the claimed invention;

(3) a finding that one of ordinary skill in the art could have applied the known "improvement" technique in the same way to the "base" device and the results would have been predictable to one of ordinary skill in the art; and

(4) whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

The Guidelines continue and state that:

If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art.

Federal Register at 57532.

Regarding the first factor, the Examiner conceded that Hanai fails to disclose "a means for carrying out a selection operation which selects one or more other combined equipment which is different from the service equipment and is suitable for being combined with the service equipment, based on model information and operational conditions of the service equipment entered from the operations section, and the constant data stored in the constant data memory means included on the user terminal." Specifically, the Examiner conceded that Hanai only teaches a system which recommends items to a user, but, the selection system resides in the server and not in the user terminal. Therefore, at a minimum, the claimed device (method or product) can be seen as an improvement over the teachings of Hanai because, in the claimed device (method or product) the processing (selection

operation) is performed at the user terminal devices. However, other improvements over the teachings of Hanai are claimed as well. For example, in claim 1, each of the user terminal devices includes: a means for storing user information entered from an operation section; a means for storing constant data on the service equipment and on one or more other combined equipment; a means for carrying out a selection operation which selects as the selection information one or more other combined equipment which is different from the service equipment and is suitable for being combined with the service equipment, based on model information and operational conditions of the service equipment entered from the operation section, and the constant data which has been stored; and, a means for requesting a display permission from the host computer for displaying the selection information selected by the means for carrying out the selection operation onto the display section on condition that the user information and the selection information are transmitted to the host computer, and displaying the selection information onto the display section only when the display permission is obtained from the host computer.

As for the second factor, the Examiner cited Yankovich. However, the Examiner did not demonstrate that Yankovich device (method or product) is comparable to either the claimed invention or to the device or system of Hanai. Further, the Examiner did not show that Yankovich was improved in the same way as the claimed invention, i.e., improved in the ways set out above including but not limited to performing the selection processing operation at the user terminal devices and displaying the results of the processing only when a permission is received from the host computer.

The Examiner did not show that by simply moving the processing from the host/server to the user terminal side as purportedly suggested by Yankovich the

Hanai device would be improved in to suggest the claims pending in the instant application.

Concerning the third factor, the Examiner did not demonstrate that one of ordinary skill in the art could have applied the "known improvement" technique in the same way to the "base" device of Hanai because, essentially, Yankovich does not teach the "improvement" purportedly shown as argued by the Examiner. Also, it is respectfully submitted that the application of the "known improvement" technique to the "base" device of Hanai would require significant experimentation.

Concerning the fourth factor, the Examiner alleges in a conclusory statement that, "it would have been obvious to one of ordinary skill in the art at the time the invention to modify Hanai by performing the processing (selection system) on the client as taught by Yankovich for the purposes of reducing server load. This is a mere unsupported conclusion. This is not a finding that " the prior art contained a "comparable" device that was improved in the same way as the claimed invention." This is not such a finding because the Examiner is attempting to select portions of the prior art and construct the claimed invention based on the blueprint set out therefore in the claims.

Under the second rationale of "Applying a Known Technique to a Known Device Ready for Improvement to Yield Predictable Results":

To reject a claim based on this rationale, Office personnel must resolve the *Graham* factual inquiries. Office personnel must then articulate the following:

(1) a finding that the prior art contained a "base" device upon which the claimed invention can be seen as an "improvement;"

(2) a finding that the prior art contained a known technique that is applicable to the base device;

(3) a finding that one of ordinary skill in the art would have recognized that applying the known technique would have yielded predictable results and resulted in an improved system; and

(4) whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

The Guidelines continue and state that:

If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art.

Federal Register at 57532.

Regarding the first factor, the Examiner conceded that Hanai fails to disclose "a means for carrying out a selection operation which selects one or more other combined equipment which is different from the service equipment and is suitable for being combined with the service equipment, based on model information and operational conditions of the service equipment entered from the operations section, and the constant data stored in the constant data memory means included on the user terminal." Specifically, the Examiner conceded that Hanai only teaches a system which recommends items to a user, but, the selection system resides in the server and not in the user terminal. Therefore, at a minimum, the claimed device (method or product) can be seen as an improvement over the teachings of Hanai because, in the claimed device (method or product) the processing (selection operation) is performed at the user terminal devices. However, other improvements over the teachings of Hanai are claimed as well. For example, in claim 1, each of the user terminal devices includes: a means for storing user information entered from an operation section; a means for storing constant data on the service equipment and on one or more other combined equipment; a means for carrying out a selection operation which selects as the selection information one or more other combined equipment which is different from the service equipment and is suitable for being combined with the service equipment, based on model information and operational conditions of the service equipment entered from the operation section, and the constant data which has been stored; and, a means for requesting a display

permission from the host computer for displaying the selection information selected by the means for carrying out the selection operation onto the display section on condition that the user information and the selection information are transmitted to the host computer, and displaying the selection information onto the display section only when the display permission is obtained from the host computer.

As for the second factor, the Examiner cited Yankovich. However, the Examiner did not demonstrate that Yankovich device (method or product) is comparable to either the claimed invention or to the device or system of Hanai. Further, the Examiner did not show that Yankovich teaches a known technique that is applicable to the device of Hanai or that Hanai could be improved in the same way as the claimed invention, i.e., improved in the ways set out above including but not limited to performing the selection processing operation at the user terminal devices and displaying the results of the processing only when a permission is received from the host computer.

The Examiner did not show that by simply moving the processing from the host/server to the user terminal side as purportedly suggested by Yankovich the Hanai device would be improved in to suggest the claims pending in the instant application.

Concerning the third factor, the Examiner did not demonstrate that one of ordinary skill in the art could have applied the "known technique" in the same way to the "base" device of Hanai because, essentially, Yankovich does not teach the "improvement" purportedly shown as argued by the Examiner. Further, the Examiner did not demonstrate that one of ordinary skill in the art would have recognized that the "known technique" of Yankovich would have yielded predictable results when applied to Hanai and resulted in an improved system.

Concerning the fourth factor, the Examiner alleges in a conclusory statement that, "it would have been obvious to one of ordinary skill in the art at the time the invention to modify Hanai by performing the processing (selection system) on the client as taught by Yankovich for the purposes of reducing server load. This is a mere unsupported conclusion. This is not a finding that " the prior art contained a "comparable" device that was improved in the same way as the claimed invention." This is not such a finding because the Examiner is attempting to select portions of the prior art and construct the claimed invention based on the blueprint set out therefore in the claims.

In summary, the Examiner's approach to the present rejection is merely an attempt to recreate the claimed subject matter by hindsight reconstruction. Recreating the claimed subject matter by piecing together the prior art is not the standard by which obviousness is measured. "Care must be taken to avoid hindsight reconstruction by using 'the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit.' " *Grain Processing Corp. v. American Maize-Products Corp.*, 840 F.2d 902, 5 USPQ2d 1788 (Fed Cir. 1988); "Determination of obviousness can not be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention." *ATD Corp. v. Lydall, Inc.*, 159 F3d 534, 48 USPQ2d 1321 (Fed Cir 1998).

Therefore, it is respectfully submitted that the present rejection is not in accordance with the Examination Guidelines issued by the Office and the Examiner has not clarified the rejections with these new Guidelines in the second Office action of February 13, 2008. In order to reject the claims under either the "Use of Known Technique to Improve Similar Devices in the Same Way" accepted rationale or the

"Applying a Known Technique to a Known Device Ready for Improvement to Yield Predictable Results" accepted rationale, the Examiner was required to make various specific findings. Those findings were not made. Therefore, as the Guidelines state, "[i]f any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art."

In light of the foregoing, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 18-0160, our Order No. NIS-16015.

Respectfully submitted,

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